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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,067	04/07/1999	HIROYUKI HARASAKI	01165.0747	1850

22852 7590 06/16/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

DAY, HERNG DER

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,067

Applicant(s)

HARASAKI ET AL.

Examiner

Herng-der Day

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-84 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 68-84 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/6/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Applicants' Reply ("Reply") to Office Action dated June 4, 2004, mailed December 6, 2004.

1-1. Claim 68 has been amended. Claims 82-84 have been added. Claims 68-84 are pending.

1-2. Claims 68-84 have been examined and rejected.

Recommendations

2. Claims 73 and 77-81 recite the limitation "the original watch design information" in each claim. For clarification purposes, the Examiner suggests that "the original watch design information" be replaced with "the original watch outward design information".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 68-72 and 74-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al., U.S. Patent 5,357,439 issued October 18, 1994, in view of d'Huart, U.S. Patent Des. 345,509 issued March 29, 1994, and further in view of MAXIS, "MAXIS: "SimCity" Company Releases New Gift Making Software; Innovative Gift Maker lets users design and

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order presents using PCs”, Business Wire, Orinda, California, November 3, 1994, extracted from DIALOG® File 810, accession # 0442038.

4-1. Regarding claim 68, Matsuzaki et al. disclose an original product outward design creating method in a design creating system having a consumer terminal (order window, column 5, lines 51-53) and maker-side host computer (design and manufacturing departments, FIG. 1) connected with the consumer terminal through an information communication network, the method comprising steps of:

providing in the maker-side host computer (design and manufacturing departments, FIG. 1), a product parts digital information indicating product constituent parts (design information, FIG. 1) and a design software (the software supporting the “product specification defining system 1”, including the software supporting the “selective indication inputting means 11”, FIG. 1 and column 6, lines 15-34) to the consumer terminal (order window, column 5, lines 51-53);

receiving in the consumer terminal (order window, column 5, lines 51-53), the product parts digital information indicating product constituent parts (design information, FIG. 1) and the design software (the software supporting the “product specification defining system 1”, including the software supporting the “selective indication inputting means 11”, FIG. 1 and column 6, lines 15-34) from the maker-side host computer (design and manufacturing departments, FIG. 1);

displaying in the consumer terminal, the product constituent parts on a display of the consumer terminal (customer indication input unit 1-1, FIG. 2 and column 6, lines 15-22) by using the design software (the software supporting the “selective indication inputting means 11”, FIG. 1 and column 6, lines 15-34);

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selecting in the consumer terminal, desired product constituent parts from the product constituent parts in accordance with an input from the consumer terminal by using the design software (selective indication inputting means 11, FIG. 1 and column 6, lines 15-34);

creating an original parts digital information by using the design software (for example, a changed specification to the displayed product designs, column 6, lines 15-22);

creating in the consumer terminal, an original product outward design information (goods specification, FIG. 1) by using the design software to combine the product parts digital information related to the desired product constituent parts and the original parts digital information (FIG. 8 and corresponding specification);

transmitting from the consumer terminal, the original product outward design information to the maker-side host computer (transmitted, column 12, lines 18-21); and

receiving in the maker-side host computer, the original product outward design information (transmitted, column 12, lines 18-21).

Matsuzaki et al. fail to expressly disclose that the “product parts digital information” and the “original product design information” are respectively the “watch parts digital information” and the “original watch design information” indicating watch constituent parts and for creating watch design. Neither do Matsuzaki et al. expressly disclose any inherent information of the original watch design information.

d’Huart discloses an ornamental design for a wristwatch (d’Huart, claim). In other words, the watch design disclosed by d’Huart indicates what the most popular watch parts digital information indicating watch constituent parts and the original watch design information for creating conventional watch design, such as, watch case information, buckle information, watch

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band information, hands information, dial-plate information, time indicator information, etc. are well known.

MAXIS discloses a new gift making software - Gift Maker. With Gift Maker, consumers create custom designs right on their computer screen for a wide variety of merchandise, ranging from polo shirts to visors to clocks. Customers use Gift Maker to select the type of item they want to personalize; choose a design template from a library of hundreds of professionally designed color graphics; customize the design and wording to suit their individual needs and submit their designs directly by modem to the factory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Matsuzaki et al. to incorporate the teachings of d'Huart to obtain the invention as specified in claim 68 because customers would be able to customize the watch design based on the most popular watch parts digital information and wording to suit their individual needs as suggested by MAXIS.

4-2. Regarding claim 69, Matsuzaki et al. further disclose comprising a step of, acquiring in the consumer terminal, production status of a product according to the original product design information (state value, FIG. 1).

4-3. Regarding claim 70, Matsuzaki et al. fail to expressly disclose confirming in the maker-side host computer, a color tone of an original design watch according to the original watch design information, although Matsuzaki et al. do provide design information using detail design CAD system based on customer requirement as shown in FIG. 1. Therefore, confirming color tone is implicitly provided because the combined teachings of Matsuzaki et al. and d'Huart

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enable the clock maker to confirm and produce a watch customized to the customer's own specifications which includes color tone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Matsuzaki et al. to incorporate the teachings of d'Huart to obtain the invention as specified in claim 70, because it enables the watch maker to confirm and produce a watch customized to the customer's own specifications in a highly efficient, commercially practical method.

4-4. Regarding claim 71, Matsuzaki et al. further disclose comprising a step of, displaying in layers in the consumer terminal, a completed figure, pattern groups of product constituent parts, and designation of parts, on a screen of the consumer terminal by using the design software (FIG. 10).

4-5. Regarding claim 72, Matsuzaki et al. further disclose comprising a step of, sequentially and selectively displaying on a screen of the consumer terminal from a large group to a small group of the product constituent parts by using the design software (the details of the item will be displayed, column 11, line 56, through column 12, line 1).

4-6. Regarding claim 74, Matsuzaki et al. further disclose comprising a step of, displaying in the consumer terminal, a plurality of competed products to be compared with one another on the same screen of the consumer terminal by using the design software (resulting designs, column 11, lines 4-12; FIG. 9).

4-7. Regarding claim 75, Matsuzaki et al. further disclose comprising a step of,

selecting location, number, length, font and color of a dial-plate message on a screen of the consumer terminal by using the design software (graphic processing function, column 9, lines 10-41).

4-8. Regarding claim 76, Matsuzaki et al. further disclose comprising a step of,

displaying a plurality of sample patterns on the same screen of the consumer terminal by using the design software (enter into “photo corner” and show samples, FIG. 8).

4-9. Regarding claim 77, d’Huart further disclose the original watch outward design information includes dial-plate information, hands information, watch case information, color information, watchband information, buckle information, time indicator information or message information (d’Huart, claim).

4-10. Regarding claim 78, Matsuzaki et al. further disclose comprising a step of,

inputting in the consumer terminal, message information independently created by the consumer, and wherein the original product outward design information includes the message information (keyboard, column 9, lines 22-25).

4-11. Regarding claim 79, Matsuzaki et al. further disclose comprising a step of,

inputting in the consumer terminal, product design information independently created by the consumer, and wherein the original product outward design information includes the product design information (enter into “craft corner” and change outer appearance, FIG. 8).

4-12. Regarding claim 80, Matsuzaki et al. further disclose the original product outward design information includes material information of the product constituent parts (the attribute includes material, column 16, line 57, through column 17, line 3).

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4-13. Regarding claim 81, Matsuzaki et al. further disclose the original product outward design information includes mechanical function information of the product constituent parts (the attribute includes strength, column 16, line 57, through column 17, line 3).

4-14. Regarding claim 82, d'Huart further disclose the original parts digital information is an original dial-plate digital image (d'Huart, claim).

4-15. Regarding claim 83, Matsuzaki et al. further disclose the original parts digital information is a digital picture image (for example, an outer appearance of product, column 6, lines 15-22).

4-16. Regarding claim 84, Matsuzaki et al. further disclose the original parts digital information is a computer graphic (for example, an outer appearance of product, column 6, lines 15-22).

5. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Matsuzaki et al., U.S. Patent 5,357,439 issued October 18, 1994, d'Huart, U.S. Patent Des. 345,509 issued March 29, 1994 as applied to claim 68, and MAXIS, "MAXIS: "SimCity" Company Releases New Gift Making Software; Innovative Gift Maker lets users design and order presents using PCs", Business Wire, Orinda, California, November 3, 1994, extracted from DIALOG® File 810, accession # 0442038, and further in view of Maxey et al., "New Riders' Reference Guide to AutoCAD Release 13", New Riders Publishing, Indianapolis, Indiana, 1995.

5-1. Regarding claim 73, Matsuzaki et al. fail to expressly disclose displaying on a screen of the consumer terminal an enlarged view of an original design watch according to the original watch outward design information by using the design software. Nevertheless, Matsuzaki et al. suggest using CAD system to provide design information as shown in FIG. 1 and using graphic computer 1-22 which has a graphic processing function (column 9, lines 31-41).

In New Riders' Reference Guide to AutoCAD Release 13, Maxey et al. "document each command, along with every prompt and dialog box feature associated with that command" (introduction, page 2). Specifically, Maxey et al. disclose:

displaying on a screen of the consumer terminal an enlarged view of an original design watch according to the original design watch information by using the design software (ZOOM, pages 756-759).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Matsuzaki et al., d'Huart, and MAXIS to incorporate the AutoCAD teachings of Maxey et al. to obtain the invention as specified in claim 73, as suggested by Matsuzaki et al.

Applicants' Arguments

6. Applicants argue the following:

(1) "The Examiner states that Matsuzaki et al. discloses in column 7, lines 4-6, the following: '1-10 denotes a combination design unit which designs the product based on the specification required by a customer.' Based on this statement, it is clear the customer does not select the desired watch constituent parts of the watch outward design in Matsuzaki et al." (page 6, paragraph 3, Reply).

(2) "the customer does not select the parts of the desired products, but inputs the specification for the desired products" (page 6, paragraph 4, Reply).

(3) "The term 'the specification' is not defined in this patent as the selection of parts" (page 7, paragraph 1, Reply).

(4) “Thus, Matsuzaki et al. does not disclose or suggest the step for creating original parts digital information by using the design software, as also recited in claim 68” (page 7, paragraph 3, Reply).

(5) “The d’Huart design patent is unrelated to the field of creating an original watch outward design using a computer, and any assertion of inherency is speculative” (page 8, paragraph 1, Reply).

(6) “The Examiner is again requested to identify by page(s) and line(s) in the Maxey et al. CAD guide the disclosure of the steps claimed in these five rejected claims” (page 8, paragraph 3, through page 9, paragraph 1, Reply).

(7) “If this knowledge is so readily available, certainly the Examiner ought to have been able to cite one publication that discloses this knowledge and establishes the motivation needed to modify the Matsuzaki et al. patent to arrive at the claimed processes” (page 9, paragraph 2, Reply).

(8) “An applicant is always permitted to discuss an individual reference to show, as examples, lack of motivation, a missing teaching or suggestion, hindsight reconstruction, lack of knowledge in the prior art, and non-relevance to distinguish over the cited references or to show how the claims avoid the references” (page 10, paragraph 1, Reply).

Response to Arguments

7. Applicants’ arguments have been fully considered.

7-1. Applicants’ arguments (1)-(3) are not persuasive. As shown in FIG. 10, Matsuzaki et al. disclose a specification includes lots of specification items. Each specification item, for example, speed, has an associated digital picture image as shown in FIG. 9. Furthermore, as

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shown in FIG. 8, customers make the desired selection for each specification item and store the specification as designed product. In other words, the term “the specification” is indeed representing the customer selected parts.

7-2. Applicants’ argument (4) is not persuasive. For the purpose of claim examination with the broadest reasonable interpretation, customer inputting information, for example, changing outer-appearance specification, meets the limitation “creating original parts digital information by using the design software”.

7-3. In response to Applicants’ arguments (5)-(6) against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7-4. Response to Applicants’ argument (7). The Examiner cites the Press Release of MAXIS to provide the needed motivation as detailed in section 4-1 above.

7-5. Response to Applicants’ argument (8). An applicant is indeed always permitted to discuss an individual reference. However, by attacking references individually where the rejections are based on combinations of references, the argument will hardly be persuasive.

Conclusion

8. Applicants’ amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30. Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jean R. Homere can be reached on (571) 272-3780. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day
June 10, 2005 H.D.

Thai Phan
Primary Examiner
AU: 2128
6/10/05